

REMARKS

Claims 18-37 are currently pending in the subject application and are presently under consideration. Claims 1-17 have been cancelled and new claims 18-37 are presented as shown on pp. 2-5 of the Reply. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments presented herein.

I. Rejection of Claims 1, 2, 5, 6, 7, and 16 Under 35 U.S.C. §102(e)

Claims 1, 2, 5, 6, 7, and 16 stand rejected under 35 U.S.C. §102(e) as being anticipated by Manchester (US 2004/0201595). It is respectfully requested that this rejection be withdrawn for at least the following reasons. The rejected claims have been cancelled and Manchester does not teach or suggest each and every element of the newly recited claims.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that “*each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added).

The subject invention relates to a mobile scanning terminal system and related method. Independent claim 17 recites *an image capture component that captures optical signals related to a product, an image analysis component that analyzes and determines product identity based at least in part upon the optical signals, and a display that displays information associated with the product and inverts or rotates the information to an optimal viewing orientation, regardless of the orientation of the system, thereby efficiently relaying data to the user*. Similarly independent claims 29 and 37 relate to a system and method including *a data retrieval component for retrieving product data relevant to a scanned product*. Manchester does not teach or suggest such claimed aspects.

As has been established in previous prosecution, the entirety of the Manchester disclosure is limited to a self-orienting display that senses characteristics of an object to be displayed and automatically rotates the display in accordance with those characteristics, particularly paragraphs [0019], [0025] and the Abstract. Paragraphs [0036] *et seq.* disclose various sensor and authentication schemes, in addition to computer media upon which aspects of that system may be embodied. However, it is readily apparent that Manchester fails to disclose or suggest the aforementioned claimed aspects, particularly the subject *image analysis component* and *data retrieval component*, as recited in the subject independent claims. Thus, Manchester cannot be construed as disclosing or suggesting each and every element of the invention as presently recited in the subject claims. In view of at least the foregoing, it is readily apparent that this rejection should be withdrawn.

II. Rejection of Claims 3, 4, 8-12, and 15 Under 35 U.S.C. §103(a)

Claims 3, 4, 8-12, and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Manchester in view of Browning (US 6,707,581). Applicant's representative respectfully submits that this rejection should be withdrawn for at least the following reasons. The rejected claims have been cancelled and Browning fails to make up for the aforementioned deficiencies of Manchester with respect to newly-recited independent claims 17, 29 and 37.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* See MPEP §706.02(j). (Emphasis added). The teaching or suggestion to make the claimed combination and the reasonable expectation of success *must both be found in the prior art* and not based on applicant's

disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Browning relates to a handheld PDA or the like that scans text or a barcode and converts the scanned image into alphanumeric text or other computer-readable information. An information retrieval agent then searches for relevant information on the Internet or other network. Browning fails to disclose or suggest *an image analysis component that analyzes and determines product identity based at least in part upon the optical signals*, as recited in independent claim 18, or a *data retrieval component for retrieving product data relevant to a scanned product* as recited in independent claims 29 and 37. It is therefore readily apparent that Browning fails to cure the deficiencies of Manchester. Further, there is nothing in the four corners of Browning that suggests a *display that inverts or rotates information to an optimal viewing orientation*, as recited in the independent claims. As such there is nothing to suggest a combination with Manchester, and one having skill in the art would not arrive at such a combination unless guided by a hindsight reading of the subject disclosure as a 20/20 roadmap to the claimed invention. For at least these reasons, Manchester and Browning, taken either alone or in combination, do not disclose each and every aspect of the present claims. Accordingly, the rejection on this ground should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [SYMBP165US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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